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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,115	10/19/2001	Ying Luo	A-70229/RMS/DHR	2856

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EXAMINER

GIBBS, TERRA C

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/029,115

Applicant(s)

LUO ET AL.

Examiner

Terra C. Gibbs

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 06 December 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2, 3, 16-27.

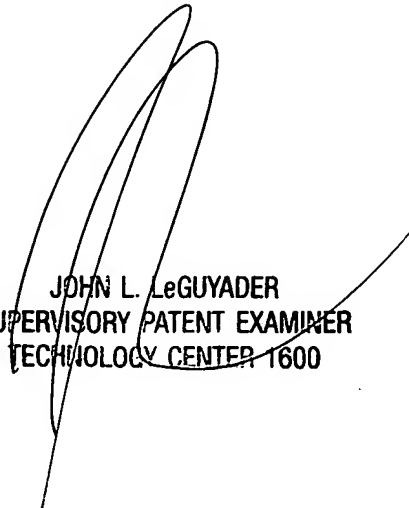
Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed amendment will not be entered because it would necessarily require new search and further consideration because the scope of claims 2 and 21 have been broadened from "98% identity to a nucleic acid" to "99% identity to a nucleic acid". Similarly, claims 16 and 22 have been broadened from "98% identity to an amino acid" to "99% identity to an amino acid". The broader scope of claims 2, 16, 21, and 22 would potentially raise new art issues not previously considered since said percentages have not been recited in any claims examined heretofore.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicants reply would overcome the 35 U.S.C. 112, first paragraph rejection against claims 2, 3, and 21 for written description. However, this rejection would be reinstated on the record against new claim 27. If entered, Applicants reply would overcome the 35 U.S.C. 102(b) rejections against claims 2, 3, 16-20 and 22-26 as being anticipated by Ippel et al. (FEBS Letters, 2000 Vol. 469:19-23). If entered, Applicants reply would overcome the 35 U.S.C. 102(b) rejection against claims 2, 3, and 16-18 as being anticipated by Plowman et al. [U.S. Patent No. 6,656,716]. It is noted that the rejections under 35 U.S.C. 102(b) would be overcome in view of Applicants amendment to the claims to recite "99% identity to a nucleic acid" and "99% identity to an amino acid".

Continuation of 5. does NOT place the application in condition for allowance because: The request addresses the claims as amended, however the claims, as amended have not been entered on the record.



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